

### **REMARKS**

The Office Action of October 7, 2003 has been reviewed and the comments therein were carefully considered. Claims 1-35 are pending in the application. No new matter has been introduced into the application. Reconsideration and allowance of the instant application are respectfully requested.

### **Rejections under 35 USC § 102**

Claims 16-19, and 21 stand rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,330,574 to Murashita.

Of the rejected claims, claims 16 and 19 are independent claims. Amended claim 16 is drawn to a method for encoding an electronic document and includes the feature of "inserting at least one code character into the electronic document to separate markup language from content." Inserting at least one code character into the electronic document to separate markup language from content is described, for example, on page 15, lines 17-23 of the present application as follows:

At step 410, a code character is inserted to separate markup language from the actual content of the e-book file. For example, the code may be Unicode character 0x0000. The Unicode character is inserted before and after each start and end tag.

The present invention is concerned with accelerating run-time searching operations and minimizing computational requirements for e-books.

Murashita discloses a tag document compressing apparatus for coding a tag document in order to decrease transmission time over a network and to save storage space on a hard disk. Col. 3, lines 12-13 and Col. 14, lines 38-42. The compressing apparatus utilizes a tag extracting unit for

scanning document type definitions of an inputted tag document to extract tags. Col. 3, lines 17-18.

A tag code table creating unit is utilized for assigning a predetermined code to the tag in the document definition on the basis of the tag extracted by the tag extracting unit to create the tag code table. Col. 3, lines 19-21. A tag coding unit codes the tag in the document instance on the basis of the tag code table creating unit. Col. 3, lines 22-24.

Murashita, however, fails to disclose the claimed feature of “inserting at least one code character into the electronic document to separate markup language from content.” At most, Murashita describes a tag discriminating unit which determines whether data in the document instance of an SGML document is a tag or not. Col. 15, lines 28-31. Therefore, for at least this reason, it is respectfully submitted that independent claim 16 is in condition for allowance.

Dependent claims 17-18 depend from claim 16 are allowable for at least the same reason as independent claim 16. In addition, dependent claim 17 is allowable for at least an additional reason. Claim 17 includes the claimed feature of “locating an attribute type within the tag.” Applicants respectfully disagree with the Office Action that Murashita discloses this feature. Murashita fails to disclose “locating an attribute type within the tag” as Murashita is concerned with tag document compression and not with attribute type compression. Therefore, for at least this additional reason, it is respectfully submitted that claim 17 is in condition for allowance.

Claim 19 is drawn to a computer readable medium having stored thereon a markup language document comprising in combination the claimed feature of “a code separating the tag from the content portion.” Applicants respectfully traverse the rejection.

As stated above with respect to independent claim 16, Murashita at most describes a tag discriminating unit which determines whether data in the document instance of an SGML document is a tag or not. Col. 15, lines 28-31. Murashita does not disclose “a code separating the tag from the

content portion.” Therefore, for at least this reason, it is respectfully submitted that independent claim 19 is in condition for allowance. Dependent claims 20-23 depend from claim 19 are allowable for at least the same reason as independent claim 19.

Claims 24-31 stand rejected under 35 U.S.C. 102(a) as being anticipated by “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999. Applicants respectfully traverse the rejections.

Independent claim 24 includes the claimed feature of “wherein the content file is pre-computed and encoded to minimize computational run-time requirements.” The Office Action fails to identify where in the cited documents this claimed feature can be found. Applicants have reviewed the Open eBook publication and respectfully submit that the Open eBook publication does not teach or suggest the claimed feature of “wherein the content file is precomputed and encoded to minimize computational run-time requirements.” Therefore, for at least this reason, Applicants submit that independent claim 24 is in condition for allowance. Dependent claims 25-31 are allowable for at least the same reason as independent claim 23 from which they ultimately depend.

### **Rejections under 35 USC § 103**

Claims 1-7, 9, 12-13, 20, 22-23, 32, and 35 stand rejected under U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 in view of “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999. Applicants respectfully traverse the rejections.

Independent claim 1 includes the claimed feature of “inserting at least one flag within the tag to form an encode tag structure.” Support for this feature can be found beginning on page 17, line 23

of the specification which provides “various flags are inserted in tags (discussed further herein with respect to Figure 4(B)) to improve run-time search operations.”

The Office Action states and Applicants agree that “what Murashita does not teach is inserting at least one flag within a tag to form an encode tag structure.” Office Action, page 4. The Office Action further states that “Open eBook teaches inserting metadata information which could be at least one flag within a tag to form an encode tag structure in section 2.2 lines 7-12. Office Action, pages 4-5. Section 2.2 lines 7-12 of the Open eBook publication states:

The x-metadata element must contain one or more instances of a meta element, analogous to the HTML 4.0 meta element, but applicable to the publication as a whole. The x-metadata element allows content providers to express arbitrary metadata beyond the data described by the Dublin Core language. Individual OEB documents may include the meta element directly (as in HTML 4.0) for document-specific metadata. This specification uses the OEB package file alone as the basis for expressing publication-level Dublin Core metadata.

Though the cited section discloses that x-metadata allows content providers to express arbitrary metadata beyond the data described by the Dublin Core language, the cited section does not address the claimed limitation of “inserting at least one flag within the tag to form an encode tag structure.” Allowing content providers to express arbitrary metadata does not disclose, teach or suggest “inserting at least one flag within the tag to form an encode tag structure.” Therefore, for at least this reason, Applicants submit that claim 1 is in condition for allowance. Dependent claims 2-9 which ultimately depend from claim 1 are allowable for at least the same reason as independent claim 1.

Independent claim 12 includes the claimed feature of “inserting a no search flag in association with the portion.” Support for this feature can be found in the specification beginning on page 20, line 15 which provides:

If a tag is determined to designate content that is not to be displayed, NOSEARCH flags are inserted around the subject content. The NOSEARCH flag indicates that the designated content is hidden and not displayed on the reading device, and therefore, need not be searched at run-time.

The Office Action states and Applicants' agree that Murashita does not teach "if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion." Office Action, page 7, lines 4-5. The Office Action further states that Open eBook does teach the claimed feature of "inserting a no search flag in association with the portion." The Applicants respectfully disagree as allowing a content provider to express arbitrary metadata does not disclose the claimed feature of claim 12. Therefore, for at least this reason, Applicants submit that claim 12 is in condition for allowance. Dependent claim 13 which ultimately depends from claim 12 is allowable for at least the same reason as independent claim 12.

Independent claim 32 includes the claimed feature of "forming a converted document, wherein the converted document has a file format comprising in combination: i) a root directory; and ii) a content directory . . . ." The Office Action on page 8 states and Applicants' agree

Murashita does not teach forming a converted document comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory.

Further, the Office Action states that "Open eBook does teach forming a converted document comprising a root directory and a content subdirectory . . . ." Applicants' respectfully disagree as the Open eBook document does not disclose the claimed feature of "forming a converted document."

The Open eBook document describes a structure for representing the content of electronic books. The Open eBook document provides a specification to content providers to ensure fidelity, accuracy, accessibility, and presentation of electronic content over various electronic book formats. Open eBook Publication Structure 1.0, Page 1. The Open eBook document only describes a general format

for e-books and is not concerned with “forming a converted document” with the use of a conversion tool. Therefore, for at least this reason, Applicants submit that claim 32 is in condition for allowance. Dependent claims 32-35 which ultimately depend from claim 32 are allowable for at least the same reason as claim 32.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view of Kucera, et al., U.S. Patent No. 4,864,502. Applicants respectfully traverse the rejection.

Independent claim 10 includes the claimed feature of “if the left and right terms are not part of a single word, inserting a word break flag between the left and right term.” The Office Action states that “Open eBook also teaches inserting additional metadata into a tag, which could be a word break flag between left and right terms in section 2.2 lines 7-17.” Office Action page 9, emphasis added.

MPEP 2143.03 states “To establish a *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” The Applicants respectfully submit that the combination of Open eBook and Kucera do not disclose, teach, or suggest “inserting a work break flag between the left and right term.” The Office Action’s assumption that additional metadata could be a work break flag does not establish a *prima facie* case for obviousness. If the current rejection is maintained, Applicants respectfully request that the Office Action point to specific teachings or suggestions in the documents showing the claimed feature. Therefore, for at least this reason, Applicants respectfully submit that independent claim 10 is in condition for allowance. Dependent claim 11 which ultimately depends from claim 10 is allowable for at least the same reason as independent claim 10.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view of Edelman et al., U.S. Patent No. 6,442,576. Applicants respectfully traverse the rejection.

Claim 14 has been amended to further clarify the feature of “replacing part of the URL with the reference string and a flag for the file.” (Emphasis Added). Support for the claimed element can be found in the specification on page 8 lines 23-26. Applicants respectfully submit that the combination of Open eBook and Edelman do not disclose, teach, or suggest the claimed feature of “replacing part of the URL with the reference string and a flag for the file.” Therefore, for at least this reason, Applicants respectfully submit that independent claim 14 is in condition for allowance. Dependent claim 15 which ultimately depends from claim 14 is allowable for at least the same reason as independent claim 14.

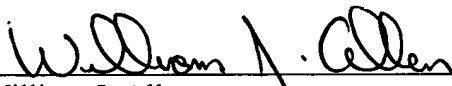
Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 in view of “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 as applied to claim 1 above, and further in view of Edelman, et al (hereafter referred to as Edelman), US 6,442,576 B1 filed 08/06/1997. Applicants respectfully submit that dependent claim 8 is allowable for at least the same reason as independent claim 1, from which dependent claim 8 ultimately depends.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

Respectfully submitted,

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William J. Allen  
Registration No. 51,393

BANNER & WITCOFF, LTD.  
10 South Wacker Drive  
Chicago, Illinois 60606  
Telephone: (312) 463-5000  
Facsimile: (312) 463-5001